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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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04/11/77  
 04/11/77 14550000 SILBERT & HENRI  
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EXAMINER

24 MAN, R

ART UNIT

PAPER NUMBER

2046

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DATE MAILED:

12/25/11:

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

7-11-64 AVAILABLE COPY

# Office Action Summary

Application No.  
**09/412,297**

Applicant(s)

Ting

Examiner  
**Robert A. Zeman**

Group Art Unit  
**1645**



☒ Responsive to communication(s) filed on Oct 5, 1999

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-49 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) \_\_\_\_\_ is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-49 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 2, and 8-12 as drawn to methods of screening for an agent that alters NELL-1 gene expression as measured by protein expression, classified in class 435, subclass 7.21.
- II. Claims 1-3-7 and 10-12 as drawn to methods of screening for an agent that alters NELL-1 gene expression as measured by RNA levels, classified in class 435, subclass 6.
- III. Claims 13 and 24 as drawn to methods of pre-screening NELL-1 modulators by measuring specific binding of said modulator to the NELL-1 protein or nucleic acid in an animal, classified in class 424, subclass 9.2.
- IV. Claims 13-16 and 19-23 as drawn to methods of pre-screening NELL-1 modulators by measuring specific binding of said modulator to the NELL-1 protein, classified in class 435, subclass 7.8.
- V. Claims 13-18 and 21-23 as drawn to methods of pre-screening NELL-1 modulators by measuring specific binding of said modulator to the NELL-1 nucleic acid, classified in class 435, subclass 6.

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- VI. Claims 25-27 and 31, drawn to methods of increasing bone mineralization by increasing endogenous NELL-1 levels by treatment with a protein, classified in class 514, subclass 2.
- VII. Claims 33-36, as drawn to methods of facilitating the repair of bone fractures by increasing the NELL-1 gene product concentration via the introduction of NELL-1 producing cells to the fracture site, classified in class 424, subclass 93.2.
- VIII. Claims 33-34, 37, 38, 42 and 43, as drawn to methods of facilitating the repair of bone fractures by increasing the expression of endogenous NELL-1 gene product, classified in class 514, subclass 2.
- IX. Claims 28-30, 32-34, 37, 39-43, as drawn to methods of facilitating bone remineralization and the repair of bone fractures by increasing the expression of NELL-1 through the introduction of an exogenous gene, classified in class 514, subclass 44.
- X. Claims 44 and 45, as drawn to methods of facilitating the repair of bone fractures by contacting bone fracture site with NELL-1 protein, classified in class 514, subclass 2.
- XI. Claims 46-49, drawn to bone graft materials, classified in class 424, subclass 488.

The inventions are distinct, each from the other because of the following reasons:

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Inventions I-X are separate and distinct from each other as they are drawn to differing methods having different steps and leading to differing results.

Inventions I-IX are separate and distinct from Invention XI in that the compounds of Invention XI cannot be used in the methods of Inventions I-IX.

Invention XI and Invention X are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the compounds of Invention XII can be used in other methods such as antibody production.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and differing classifications, restriction for examination purposes as indicated is proper.

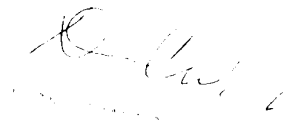
Many claims are generic claims and are incorporated into multiple invention groups and will be examined with whatever group is elected by Applicant, to the extent that they read on the elected invention..

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A. Zeman whose telephone number is (703) 308-7991. The examiner can be reached between the hours of 7:30 am and 4:00 pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, Donna Wortman, Primary Examiner can be reached at (703) 308-1032 or the examiner's supervisor, Lynette Smith, can be reached at (703)308-3909.



Robert A. Zeman

November 29, 2000